



[10191/4135]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

-----X
In re Application of: Peter REHBEIN et al. : Examiner: K. Lee
: :
: :
For: ELECTRICAL CONTACT : :
: :
: Art Unit: 2832
Filed: February 16, 2005 : :
: :
Serial No.: 10/524,726 : :
-----X

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on
Date: September 12, 2007
Signature: A. L. L.

TRANSMITTAL

SIR:

Transmitted herewith for filing in the above-identified patent application, please find an Appeal Brief pursuant to 37 C.F.R. § 41.37.

The Commissioner is authorized to charge the Appeal Brief fee of \$500.00, and any other fees (or credit any overpayment) that may be required in connection with this communication to the deposit account of **Kenyon & Kenyon LLP**, deposit account number **11-0600**. A copy of this transmittal is enclosed for that purpose.

Applicants also hereby request a five-month extension of time in which to respond to the Notice of Appeal which is believed to have been received by the United States Patent and Trademark Office on February 12, 2007, for which a two month response period of April 12, 2007 is required. The extended period is believed to expire on September 12, 2007. The Commissioner is hereby authorized to charge the 37 CFR §1.17(a) extension fee of **\$2,160.00** to the deposit account of **Kenyon & Kenyon LLP** deposit account number **11-0600**.

Dated: September 12, 2007

Respectfully submitted,
KENYON & KENYON LLP

By: Gerard A. Messina
Gerard A. Messina
(Reg. No. 35,952)

09/18/2007 CCHAU1 00000007 110600 10524726
01 FC:1255 2160.00 DA

One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646



[10191/4135]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Peter REHBEIN et al.

For: ELECTRICAL CONTACT

Filed: February 16, 2005

Serial No.: 10/524,726

Examiner: K. Lee

Art Unit: 2832

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on:

Date:

February 12, 2007

Signature:

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

SIR:

On February 6, 2007, Appellants submitted a Notice of Appeal from the last decision of the Examiner contained in the Final Office Action dated September 6, 2006 in the above-identified patent application. The Notice of Appeal is believed to have been received by the United States Patent and Trademark Office on February 12, 2007.

In accordance with 37 C.F.R. § 41.37, this brief is submitted in support of the appeal of the rejections of claims 7 and 9 to 13. For at least the reasons set forth below, the final rejections of claims 7 and 9 to 13 should be reversed.

1. REAL PARTY IN INTEREST

The real party in interest in the present appeal is ROBERT BOSCH GMBH of Stuttgart in the Federal Republic of Germany, which is the assignee of the entire right, title and interest in and to the present application.

2. RELATED APPEALS AND INTERFERENCES

There are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to

Appellants or the assignee, ROBERT BOSCH GMBH, “which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.”

3. STATUS OF CLAIMS

Claims 1 to 6 and 8 have been canceled.

Claims 7 and 9 to 13 are pending.

Claims 7 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Published Patent Application No. 63-221517 (“JP ‘517”).

Claims 10 to 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of JP ‘517 and U.S. Patent No. 5,800,932 (“Suzuki et al.”).

A copy of the appealed claims, *i.e.*, claims 7 and 9 to 13, is attached hereto in the Claims Appendix.

4. STATUS OF AMENDMENTS

In response to the Final Office Action dated September 6, 2006, Appellants submitted a “Response” on December 6, 2006. The Response did not include any proposed amendments to the claims. It is noted, however, that the Advisory Action dated December 28, 2006 indicates that “[f]or purposes of appeal, the proposed amendment(s) . . . will not be entered,” despite the fact that no proposed amendments to the claims were included in the Response. It is Appellants’ understanding that the claims as included in the annexed “Claims Appendix” reflects the current claims.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 7 relates to an electrical contact. Claim 7 recites that the electrical contact 1 includes a metallic substrate 2. *Specification*, page 4, lines 21 to 22, *Figure*. Claim 7 further recites that the electrical contact 1 includes a contact layer 3 in the form of a gradient layer applied on the metallic substrate 2. *Specification*, page 4, lines 25 to 26 and page 4, line 3, *Figure*. Claim 7 recites that the gradient layer is composed of at least two elements. *Specification*, page 3, lines 6 to 7. Claim 7 recites that the at least two elements include a first element and a second element, wherein one of: (a) the first element is silver and forms an alloy with the second element, the second element including one of indium and tin, (b) the first element is tin and the second element is phosphorus, and (c) the first element is indium and the second element is tin. *Specification*, page 3, lines 7 to 9.

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Whether claims 7 and 9 are patentable under 35 U.S.C. § 102(b) over JP '517.
- B. Whether claims 10 to 13 are patentable under 35 U.S.C. § 103(a) over the combination of JP '517 and Suzuki et al.

7. **ARGUMENT**

A. **Rejection of Claims 7 and 9 Under 35 U.S.C. § 102(b)**

Claims 7 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by JP '517. It is respectfully submitted that JP '517 does not anticipate the present claims for at least the following reasons.

As an initial matter, it is noted that an English-language translation of JP '517 has not been provided to Appellants and that the present rejection is apparently based on an English-language abstract of JP '517, which bears a date of September 3, 2006, which is after the October 2, 2003 International Filing Date of the present application. Since, on its face, the English-language abstract of JP '517 itself does not constitute prior art against the present application, this rejection should be reversed. To the extent that the Japanese-language text of JP '517 might be relied upon, the present rejection should be reversed since the Office has not provided an English-language translation thereof. M.P.E.P. § 706.02(II) ("If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection" (emphasis added)). Notwithstanding the foregoing, it is respectfully submitted that the present rejection should be reversed for the following additional reasons.

It is, of course, "well settled that the burden of establishing a *prima facie* case of anticipation resides with the [United States] Patent and Trademark Office." *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As set forth above, claim 7 recites that an electrical contact includes a contact layer in the form of a **gradient layer** composed of at least two elements. The Final Office Action contends that JP ‘517 discloses “an electrical contact comprising . . . a contact layer in the form of a gradient layer composed of indium and tin” without any specific reference to where the English-language abstract of JP ‘517 is considered to make such a disclosure. Furthermore, the Advisory Action contends that “[c]ontact layer being composed of Indium and tin alloy is indeed a gradient layer (A change in concentration of indium and/or tin.),” again without any specific reference to where the English-language abstract of JP ‘517 is considered to make such a disclosure. The English-language abstract of JP ‘517 merely refers to various “coating layers” without any mention whatsoever as to the coating layers being arranged as a **gradient layer**. In this regard, the English-language abstract of JP ‘517 mentions that “[c]ontact has a lower coating layer composed of Ag or Ag alloy on metal substrate surface, and an upper coating layer composed of Sn, Pd, In, Cd or alloy on the lower coating surface.” There is absolutely no indication whatsoever that the lower coating layer and the upper coating layer are arranged as a **gradient layer**. The Advisory Action refers to “page 3, lines 20-23 of the current specification disclos[ing] that ‘proportion of the one element in the contact layer basically may run the range between 0% and 100% in the gradient direction,’” “[w]here 0% seems to mean no change in concentration.” These statements are incomprehensible and apparently reflect a misapprehension of the subject matter claimed. The Specification describes, for example, at page 3, lines 14 to 22, a gradient layer consistent with its ordinary meaning, to wit:

A gradient layer within the meaning of the present invention is to be understood as a contact layer in which the proportion of the two elements changes in the direction of the normal of the substrate plane. For instance, the tin proportion in a silver matrix or silver/tin alloy may decrease in the direction facing away from the substrate. The change in the element proportions of the contact layer may be linear, in which case a linear concentration gradient is present. As an alternative, however, it may also be a concentration gradient that varies according to a step function. The proportion of the one element in the contact layer basically may run the range between 0% and 100% in the gradient direction.

From the English-language abstract of JP ‘517, it is plainly apparent that the upper coating layer and lower coating layer are not arranged according to a **gradient layer** but rather but abruptly transition between the upper coating layer and the lower coating layer without a gradient transition therebetween. As such, it is plainly apparent that JP ‘517 does not disclose, or even suggest, all of the features included in claim 7, including “a contact

layer in the form of a **gradient layer**.” Consequently, it is respectfully submitted that JP ‘517 does not anticipate claim 7, or claim 9, which depends from claim 7.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

B. Rejection of Claims 10 to 13 Under 35 U.S.C. § 103(a)

Claims 10 to 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of JP ‘517 and Suzuki et al. It is respectfully submitted that the present rejection should be reversed for at least the following reasons.

As an initial matter, and as more fully set forth above, it is respectfully submitted that the present rejection should be reversed for at least the reasons that the English-language abstract of JP ‘517 does not constitute prior art against the present application and that an English-language translation of JP ‘517 has not been provided. Notwithstanding the foregoing, it is respectfully submitted that the present rejection should be reversed for at least the following additional reasons.

Among the requirements for establishing a *prima facie* case of obviousness is that the references relied upon must disclose or suggest all of the features claimed. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 10 to 13 ultimately depend from claim 7 and therefore include all of the features included in claim 7. As more fully set forth above, JP ‘517 does not disclose or even suggest all of the features of claim 7, from which claims 10 to 13 ultimately depend. Suzuki et al. are not relied upon for disclosing or suggesting the features of claim 7 not disclosed by JP ‘517. Indeed, Suzuki et al. do not disclose, or even suggest, the features of claim 7 not disclosed by JP ‘517. As such, it is respectfully submitted that the combination of JP ‘517 and Suzuki et al. does not render unpatentable claims 10 to 13, which ultimately depend from claim 7.

In view of all of the foregoing, reversal of this rejection is respectfully requested.

8. CLAIMS APPENDIX

A “Claims Appendix” is attached hereto and appears on the one (1) page numbered “Claims Appendix.”

9. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132. No other evidence has been entered by the Examiner or relied upon by Appellants in the appeal. An "Evidence Appendix" is nevertheless attached hereto and appears on the one (1) page numbered "Evidence Appendix."

10. RELATED PROCEEDINGS APPENDIX

As indicated above in Section 2, above, "[t]here are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellants or the assignee, ROBERT BOSCH GMBH, 'which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.'" As such, there no "decisions rendered by a court or the Board in any proceeding identified pursuant to [37 C.F.R. § 41.37(c)(1)(ii)]" to be submitted. A "Related Proceedings Appendix" is nevertheless attached hereto and appears on the one (1) page numbered "Related Proceedings Appendix."

11. CONCLUSION

For at least the reasons indicated above, Appellants respectfully submit that the art of record does not disclose or suggest the subject matter as recited in the claims of the above-identified application. Accordingly, it is respectfully submitted that the subject matter as set forth in the claims of the present application is patentable.

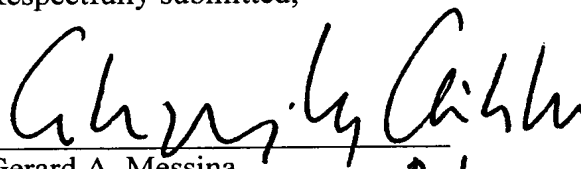
In view of all of the foregoing, reversal of all of the rejections set forth in the Final Office Action is therefore respectfully requested.

Respectfully submitted,

Dated:

September 12, 2007

By:

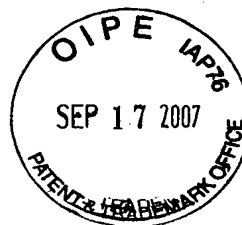

Gerard A. Messina
Reg. No. 35,952
PN 42,144

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646



CLAIMS APPENDIX

7. An electrical contact comprising:
a metallic substrate; and
a contact layer in the form of a gradient layer applied on the metallic substrate, the gradient layer being composed of at least two elements, the at least two elements including a first element and a second element, wherein one of: (a) the first element is silver and forms an alloy with the second element, the second element including one of indium and tin, (b) the first element is tin and the second element is phosphorus, and (c) the first element is indium and the second element is tin.
9. The electrical contact according to claim 7, wherein the gradient layer has a thickness of between about 1 μm and 3 μm .
10. The electrical contact according to claim 7, wherein the gradient layer has a noble-metal cover layer at least regionally.
11. The electrical contact according to claim 10, wherein the noble-metal cover layer has a thickness of between about 0.1 μm and 3 μm .
12. The electrical contact according to claim 10, wherein the noble-metal cover layer is composed of at least one of Au, Ru, Pt and Pd.
13. The electrical contact according to claim 7, wherein the gradient layer is applied on the substrate according to one of a galvanic method and a PVD method.



EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§1.130, 1.131, or 1.132. No other evidence has been entered by the Examiner or relied upon by Appellants in the appeal.



RELATED PROCEEDINGS APPENDIX

As indicated above in Section 2 of this Appeal Brief, “[t]here are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellants or the assignee, ROBERT BOSCH GMBH, ‘which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.’” As such, there no “decisions rendered by a court or the Board in any proceeding identified pursuant to [37 C.F.R. § 41.37(c)(1)(ii)]” to be submitted.